

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG R. GROSE

Appeal No. 1999-2211
Application No. 08/620,427

ON BRIEF

Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 7, 8, and 10. Claims 11-18 have been allowed¹.

BACKGROUND

¹ An amendment (Paper No. 15, filed May 8, 1998) submitted subsequent to the final rejection was entered by the examiner (Paper No. 16, mailed May 20, 1998).

Appellant's invention relates to a stethoscope carrier.
An understanding of the invention can be derived from a
reading of

exemplary claim 7, which is reproduced as follows:

7. A stethoscope carrying device, which comprises:
an anchoring mechanism for said stethoscope carrying
device;
a means for holding and transporting a stethoscope; and
a means for releasably retaining the stethoscope ear
pieces.

The prior art references of record relied upon by the
examiner in rejecting the appealed claims are:

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| Collins | 3,797,717 | Mar. 19, 1974 |
| Bott et al. (Bott) | 5,221,032 | Jun. 22, 1993 |

Claims 7, 8, and 10 stand rejected under 35 U.S.C. §
102(b) as being anticipated by Collins.

Claim 8 stands rejected under 35 U.S.C. § 102(e)² as anticipated by Bott.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 18, mailed October 19, 1998) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 17, filed September 11, 1998) and supplement to the appeal brief (Paper No. 23, filed July 9, 2001) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the

² It is unclear as to why the examiner relies upon 35 U.S.C. § 102(e) instead of § 102(b), as the Bott patent issued almost three years prior to the filing of the application before us on appeal.

rejections advanced by the examiner, and the evidence of anticipation relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm-in-part.

We consider first the rejection of claims 7, 8, and 10 under 35 U.S.C. § 102(b) as anticipated by Collins. The examiner's position (answer, pages 2 and 3) is that "[t]he person's neck, which is located posteriorly of the means for holding and transporting, is a means for retaining the ear pieces and the tubing."

Anticipation is a question of fact. In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by our reviewing court in Kalman v. Kimberly-Clark

Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983),
cert. denied, 465 U.S. 1026 (1984), it is only necessary for
the claims to "'read on' something disclosed in the reference,
i.e., all limitations of the claim are found in the reference,
or 'fully met' by it."

Appellant asserts (brief, page 7) that he "is unaware of
any basis in patent law, rules, or cases for considering a
person who uses an invention to be an element of that
invention." Appellant further asserts (id., page 9) that "the
neck of the person A does not qualify as 'a means for
releasably retaining the tubing of the stethoscope' as
requires by claim 7 of the present application or as 'a means
for retaining the tubing of the stethoscope' as required by
claim 8."

We note at the outset that the language "means for
releasably retaining the stethoscope ear pieces" of claim 7
and "means for retaining the tubing of the stethoscope" of
claim 8
are in "means plus function" format. We find no structure set
forth elsewhere in these claims for carrying out the functions
of "releasably retaining the stethoscope ear pieces" or

"retaining the tubing of the stethoscope." Collins is directed to a receptacle for a stethoscope chest piece, and states (col. 1, lines 18-22) that "[i]t is an object of this invention therefore to provide a receptacle to receive and to hold the chest piece of a stethoscope to prevent the same from dangling and from swinging while the binaurals are secured to the neck of the user" and (col. 2, lines 49 and 50) that the stethoscope binaurals 53 are "in a holding position about the neck of the operator A." From the disclosure of Collins that the binaurals are secured in a holding position from the neck of the user, we find that the neck of the user retains the stethoscope ear pieces to the user. We further find that the ear pieces of the stethoscope are releasably retained because the ear pieces (claim 7) are capable of being released from the user's neck by pulling the ear pieces apart with the user's hands. The tubing (claim 8) is not retained by the neck of the user, but rather hangs loose. However, even assuming arguendo that the tubing of the stethoscope is broadly considered to be retained by the neck of the user as advanced by the examiner (answer, pages 2 and 3) we find that the neck of the user is not an equivalent structure to the

tubing and ear piece retaining means disclosed in the specification, as required by 35 U.S.C. § 112, sixth paragraph.

The specification discloses the ear piece retaining means to be the vertical ear piece retaining grooves 12 and vertical ear piece retaining groove keepers 28, which are part of stethoscope carrier 10 (pages 5-7). In addition, the means for retaining the tubing are side tubing retainers 22 and arched tubing shelf/retainer 20, which are disclosed as being part of stethoscope carrier 10 (page 6). While we are not reading into the claims limitations that are not found therein, we find that the neck of the user is not equivalent to the tubing and ear piece retaining structures found in appellant's specification, as required by 35 U.S.C. §112, sixth paragraph. As stated by the court in In re Prater, 415 F.2d 1393, 1406, 162 USPQ 541, 551-52, (CCPA 1969):

It is quite clear that claim 10, in typical means-plus-function language as expressly permitted by the third³ paragraph of 35 U.S.C. § 112, does not encompass the human being as the 'means' or any part thereof. . . [citations omitted]. The pencil, paper,

³ Now sixth paragraph of 35 U.S.C. § 112.

and ruler-referred to by the board in regard to 35 U.S.C. 102-do not anticipate the claimed 'means' since the former additionally requires human intervention.

See also In re Bernhart, 417 F2d. 1395, 1399, 163 USPQ 611, 615 (CCPA 1969) where the court stated:

The claims also define the invention as having plotting means for drawing lines or for illustrating an object. When such functional language is used in a claim, 35 U.S.C. § 112 states that "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof". The specification here mentions only mechanical drafting machines. The claims therefore cover, under section 112, only such mechanical drafting machines and their equivalents. We know of no authority for holding that a human being, such as a draftsman, could ever be the equivalent of a machine disclosed in a patent application, and we are not prepared to so hold in this case.

In addition, we add that the neck of the user does not meet either the claimed means for releasably retaining the ear pieces (claim 7) or the means for retaining the tubing (claim 8) because the neck of the user is not part of Collins' receptacle holder.

From all of the above, we conclude that Collins does not anticipate independent claims 7, 8, or dependent claim 10. Accordingly, the rejection of claims 7, 8, and 10 under 35 U.S.C. § 102(b) is therefore reversed.

We turn next to the rejection of claim 8 under 35 U.S.C. § 102(e) as anticipated by Bott. Appellant asserts (brief, page 6) "that elements 18 and 22 of the Bott patent do not constitute means for retaining the tubing of the stethoscope." We find that Bott discloses a torso mounted holder tray assembly which is approximately twelve inches from front-to-back and sixteen inches from side-to-side (col. 4, lines 40-42). Bott discloses that the main panel 22 of tray 12 has a peripheral rim 24 having an upwardly and outwardly inclined orientation in cross section, and is defined by relatively straight sides and rounded corners, except for the rear of the tray which conforms to the torso of the wearer (col. 3, lines 1-13). In addition, interior rim 28 is configured to support a plate (col. 3, lines 16-18). The interior rim has a plurality of circumferential locations containing a plurality of radially-inwardly projecting protrusions 30 which serve as a plurality of snap-in features for retaining a flexible plate (col. 3, lines 18-24). Additionally, tray 12 includes a pair of clips 36 having triangular shapes defining wedge-shaped cavities 36A between the clips 36 and the main panel 22 for

holding napkins (col. 3, lines 35-38). From the disclosure of Bott, we find that each of the peripheral rim 24, inwardly projecting protrusions 30 on interior rim 28, and clips 30 will retain the tubing of a stethoscope.

We agree with appellant's assertion (brief, page 6) that the term "retaining" suggests more than balancing an item, and that it suggests that the item will not be easily dislodged. However, we find that the base (main panel) 22 of the tray 12 will support a stethoscope, and that each of the clip, rim 28 and protrusions 30, and peripheral rim 24 will retain a stethoscope tube on the tray, such that the tubing will not be easily dislodged. Peripheral rim 23 will retain stethoscope tube on the tray because the peripheral rim is an upstanding wall. Interior rim 28 with inwardly projecting protrusions 30 will retain the tubing because the protrusions project inwardly from the top of upwardly projecting wall 28, which is high enough to retain a plate. Clips 36 with wedge-shaped cavities 36A will retain the tubing of a stethoscope because of the nature of the wedge-shape, and its proximity to interior rim 28. Thus, we are unpersuaded by appellant's

argument (brief, page 7) that "any relatively slight tipping of element 22 of the Bott patent would cause the tubing of the stethoscope, if not the entire stethoscope, to be dislodged and fall from element 22 of the Bott patent." Accordingly, we find that claim 8 is so broadly drafted as to read on Bott in an unintended fashion. The rejection of claim 8 under 35 U.S.C. § 102(e) is therefore affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 7, 8, and 10 under 35 U.S.C. § 102(b) as anticipated by Collins is reversed. The rejection of claim 8 under 35 U.S.C. § 102(e) as anticipated by Bott is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LEE E. BARRETT

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